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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,810	08/05/2002	Lutz Brandt	FA-1068	3040
7590 08/02/2004			EXAMINER	
Steven C Benjamin			TSOY, ELENA	
E I Dupont De Nemours and Company			ART UNIT	
Legal Patents			PAPER NUMBER	
Wilmington, DE 19898			1762	

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/089,810	Applicant(s) BRANDT ET AL.	
	Examiner Elena Tsoy	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                             | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6/10/04</u> | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment***

1. Amendment filed on June 10, 2004 has been entered. Claims 10-24 are pending in the application.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 10, 12, 13, 15, 19-24** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Betz et al (US 6,261,645) in view of Bishop et al (US 4,609,718, which corresponds to EP 204161) for the reasons of record as set forth in Paragraph No. 4 of the Office Action mailed on March 29, 2004.
4. **Claims 11, 14, 16-18** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Betz et al (US 6,261,645) in view of Bishop et al (US 4,609,718, which corresponds to EP 204161), further in view of Heil et al (US 4,666,783) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on March 29, 2004.

***Response to Arguments***

5. Applicants' arguments filed June 10, 2004 have been fully considered but they are not persuasive.

Applicants argue that claimed invention is not obvious over Betz et al in view of Bishop et al since (i) Bishop et al describes that any organic diisocyanate such as a diisocyanate in which a

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linear aliphatic chain containing at least 6 carbon atoms separates the two isocyanate groups (which is not a direct pointer to acyclic aliphatic diisocyanate having 8 C atoms) can be used to form the acrylate-terminated oligomers, (ii) Bishop et al fail to indicate that such diisocyanates can be used to make the urethane methacrylates of Applicant' claimed invention, and (iii) acyclic aliphatic diisocyanate having 8 C atoms are not utilized in any of Bishop et al' examples.

The Examiner respectfully disagrees with this argument.

As to (i), "a diisocyanate in which a linear aliphatic chain containing at least 6 carbon atoms separates the two isocyanate groups" of Bishop et al is a direct pointer to acyclic aliphatic diisocyanate having 8 C atoms since a term "at least" includes 6 atoms.

As to (ii), Betz et al show that processes for preparation of urethane methacrylates are well described in the art (cf. e.g. Bishop et al) (See column 7, lines 14-54). Bishop et al describes that any organic diisocyanate such as a diisocyanate, in which a linear aliphatic chain containing at least 6 carbon atoms separates the two isocyanate groups, can be used to form urethane methacrylates. Therefore, one of ordinary skill in the art at would understand that any organic diisocyanate such as a diisocyanate, in which a linear aliphatic chain containing at least 6 carbon atoms can be used in well known processes for preparation of urethane methacrylates of Betz et al.

In other words, a secondary reference of Bishop et al is relied upon not to show the urethane methacrylates of Applicant' claimed invention, but to show that in well known processes for making urethane acrylates (methacrylates), any organic diisocyanate such as a diisocyanate, in which a linear aliphatic chain containing at least 6 carbon atoms separates the two isocyanate groups, can be successfully used.

As to (iii), it is held that PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN. See Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354,

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1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."). NONPREFERRED EMBODIMENTS CONSTITUTE PRIOR ART. **Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments.** See MPEP 2123. Therefore, Pettus does teach that the process can be used for coating a chrome plated substrate, may be with inferior results than for aluminum substrates. But again, it is expected since according to Applicants "It is well known in the art that chrome surfaces are more difficult to coat than aluminum".

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'ETsoy', is centered on the page.

Elena Tsoy  
Primary Examiner  
Art Unit 1762

July 29, 2004